



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,813	12/14/2001	Wayne Cohen	A33677	6026

21003 7590 06/02/2003

BAKER & BOTTS  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
----------

MIGGINS, MICHAEL C

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 06/02/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/021,813

Applicant(s)

COHEN, WAYNE

Examiner

Michael C. Miggins

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 1 is objected to because of the following informalities: in line 6, the term "... cylindrical internal ..." should be changed to "- - cylindrical internal surface - -" it is believed that omission of the term "surface" was a type-o. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hunt (U.S. Patent No. 4,224,364).

Hunt teaches a hollow shell article formed of three joined plastic parts (Figs. 1 and 9 and column 2, lines 52-59), including a first end part having accessible internal and external partial shell surfaces (11 from Figs. 1 and 9 and column 3, line 63 through column 4, line 68), said first end part having a first mating edge structure (11 from Figs. 1 and 9 and column 3, line 63 through column 4, line 68), a second end part having accessible internal and external surfaces, said second part having a second mating edge structure (12 from Figs. 1 and 9 and column 3, line 63 through column 4, line 68), and a third intermediate part having an external surface and a substantially cylindrical

Art Unit: 1772

internal surface (13 from Figs. 1 and 9 and column 3, line 63 through column 4, line 68), said third part including third and fourth mating edges arranged to engage said first and second mating edges respectively (since 13 from Figs. 1 and 9 has ledges which engage and connect shell pieces 11 and 12), wherein one of said first and third mating edges comprises an external ledge and the other of said first and third edges comprises an internal ledge (since 11 from Figs. 1 and 9 overlaps intermediate piece 13 from Figs. 1 and 9), wherein each of said ledges is formed of a cylindrical surface and a perpendicular surface (since 13 from Figs. 1 and 9 has a cylindrical bore with ledges to engage and connect pieces 11 and 12 from Figs. 1 and 9) and wherein at least a portion of one of said end parts overlies a portion of said intermediate part (since both pieces 11 and 12 from Figs. 1 and 9 overlap the ledges of intermediate piece 13 from Figs. 1 and 9) (applies to instant claims 1-3 and 8).

In claim 1 applicant recites the limitation requiring that the plastic parts be molded. However, such a limitation is a method limitation contained in a product claim and has been given little to no patentable weight since it has been found that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Art Unit: 1772

4. Claims 9-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ballu (U.S. Patent No. 4,936,483).

Ballu teaches a hollow shell article comprising a first end part having an end shell portion (2 from Fig. 1 and column 3, line 60 through column 4, line 68) having a shell edge and a tubular extension projecting from said shell edge (4 from Fig. 1 and column 3, line 60 through column 4, line 68), at least one intermediate part surrounding said tubular extension (11 from Fig. 1 and column 3, line 60 through column 4, line 68) and a second end part having a second end shell portion having an edge and an interior mating structure formed on said edge and receiving said tubular extension (1 from Fig. 1 and column 3, line 60 through column 4, line 68), wherein said intermediate part includes a bore for closely surrounding said tubular extension (since intermediate piece 11 from Fig. 1 is a ring which surrounds tubular member 4 from Fig. 1) and wherein said tubular extension is provided with external ridges (piece 2 from Fig. 1 has ridges 12 from Fig. 1), and wherein said intermediate part has a central bore and at least one projection extending into said central bore (since intermediate piece has a projection which projects into groove 10 from Fig. 1) (applies to instant claims 9-10 and 13).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt (U.S. Patent No. 4,224,364).

Hunt discloses the claimed invention except for the shape of the perpendicular surfaces recited in claim 4. However, Hunt teaches that the housing sections can be of a shape other than round which suggests that the intermediate layer 13 from Figs. 1 and 9 can be of a different shape as well. Thus one of ordinary skill in the art would have recognized that the shape of the intermediate member 13 from Figs. 1 and 9 would be readily determined through routine experimentation depending on the desired end results absent some showing of unexpected results. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the intermediate piece 13 from Figs. 1 and 9 with the shape recited in instant claim 4 in order to provide improved connection between pieces 11-13 from Figs. 1 and 9 and/or to prevent radial rotation of pieces 11 and 12 from Figs. 1 and 9 about intermediate 13 from Figs. 1 and 9, since it has been held that a change in shape involves only routine skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

7. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt (U.S. Patent No. 4,224,364) in view of Kraft (U.S. Patent No. 4,212,460).

Hunt discloses applicant's invention substantially as claimed. However, Hunt fails to disclose one of said first and third mating edges comprises a ridge and the other

Art Unit: 1772

of said first and third mating edges comprises a groove and wherein each of said ridge and said groove are defined by two cylindrical surfaces.

Kraft teaches the mating of two hemispheres via ridges and grooves (see Figs. 6 and 9-11 and column 2, lines 11-68) for the purpose of self-centering and to provide a water-tight seal. Thus it would have been obvious to use the ridge and groove connecting mechanism of Kraft in the mating of pieces 11-13 from Figs. 1 and 9 of Hunt to arrive at applicant's claimed structure of one of said first and third mating edges comprises a ridge and the other of said first and third mating edges comprises a groove and wherein each of said ridge and said groove are defined by two cylindrical surfaces in view of the fact that Hunt teaches applicant's first, second and third plastic parts as discussed above (applies to instant claims 5-6).

Therefore it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to have provided one of said first and third mating edges comprising a ridge and the other of said first and third mating edges comprising a groove and wherein each of said ridge and said groove are defined by two cylindrical surfaces in the hollow shell article of Hunt in order to provide self-centering and to provide a water-tight seal as taught or suggested by Kraft.

Hunt discloses the claimed invention except for the shape of the perpendicular surfaces recited in claim 7. However, Hunt teaches that the housing sections can be of a shape other than round which suggests that the intermediate layer 13 from Figs. 1 and 9 can be of a different shape as well. Thus one of ordinary skill in the art would have recognized that the shape of the intermediate member 13 from Figs. 1 and 9

Art Unit: 1772

would be readily determined through routine experimentation depending on the desired end results absent some showing of unexpected results. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the intermediate piece 13 from Figs. 1 and 9 with the shape recited in instant claim 7 in order to provide improved connection between pieces 11-13 from Figs. 1 and 9 and/or to prevent radial rotation of pieces 11 and 12 from Figs. 1 and 9 about intermediate 13 from Figs. 1 and 9, since it has been held that a change in shape involves only routine skill in the art (applies to instant claim 7). *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ballu (U.S. Patent No. 4,936,483).

Ballu teaches that at least said first and said intermediate parts are fabricated from plastic (column 1, lines 41-56) (applies to instant claim 11).

Ballu discloses applicant's invention substantially as claimed. However, Ballu fails to disclose that at least said first and said intermediate parts are fabricated from a different color plastic. However, Thus one of ordinary skill in the art would have recognized that the material selected as the colored plastic would be readily determined through routine experimentation depending on the desired end results absent some showing of unexpected results. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided different colored plastics for the first and intermediate parts in order to provide camouflage or



Art Unit: 1772

provide colored parts for ease of assembly, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (applies to instant claims 11).

*In re Leshin*, 125 USPQ 416.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ballu (U.S. Patent No. 4,936,483) in view of Wiltshire et al. (U.S. Patent No. 4,219,125).

Ballu discloses applicant's invention substantially as claimed. However, Ballu fails to disclose two or more of said intermediate parts, and wherein at least a portion of one of said intermediate parts overlies a portion of another intermediate part.

Wiltshire et al. teach two or more of said intermediate parts, and wherein at least a portion of one of said intermediate parts overlies a portion of another intermediate part (47 and 36 from Fig. 2 and column 4, lines 34-68) (applies to instant claim 12) for purpose of providing further protection from detachment of two shell halves.

Therefore it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to have provided two or more of said intermediate parts, and wherein at least a portion of one of said intermediate parts overlies a portion of another intermediate part in the hollow shell article of Ballu in order to provide further protection from detachment of two shell halves as taught or suggested by Wiltshire et al..

Art Unit: 1772

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is (703) 305-0915. The examiner can normally be reached on Monday-Friday; 1:30-10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pyon Harold can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

MCM *hck*  
May 30, 2003

*Harold Pyon*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
*1772* *5/30/13*